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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joel G. Hassell

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ROPES & GRAY LLP

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PARRA, OMAR S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/734,505	Applicant(s) HASSELL ET AL.	
	Examiner OMAR PARRA	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-145 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 106-145 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/28/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 05/28/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments:

Applicant argues that "*Schein fails to teach or suggest providing a list of selectable options, where one option allows the user to access information for at least one broadcast television and at least one recorded program stored on the digital storage device*", (page 3, second paragraph). To this matter, the examiner respectfully disagrees.

Schein teaches an electronic program guide (Fig. 6) that has a listing of multiple selectable options (pull-down menu with all the options for selection), where one is "Channel Guide" that lets the user access information of broadcast television (grid with broadcast program schedule, as shown in Figs. 7A, 7D, 8A, etc) which includes or identifies information of programs that were sent to be recorded ([0054]). Therefore, the selectable option "Channel Guide" provides access to information of at least one broadcast program and recorded programs.

Schein also has a second selectable options that lets the user access a list of recorded programs (Third option, "Recordings", Fig. 6B; [0051]-[0053]). In this way, Schein also complies with the recited limitations of the claims.

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Applicant also argues that Young's two options "On Grid Prog" and "Recorded Programs" do not provide access to both broadcast program and recorded programs, pages 3 and 4, last and first paragraphs, respectively. To this matter, the examiner respectfully disagrees.

Young, as entirely incorporated by reference by Schein, further teaches a listing of selectable options (horizontally listed 1. "Pending Programs", 2. "Recorded Programs", 3. "Linked titles" and 4. "On Grid Prog", Fig. 4). The "On Grid Prog" option, once selected, provides access to program information of broadcast programs that includes visually-distinct cells for programs that are recorded (col. 8 lines 8-35). Therefore, this selectable option gives access to information of at least one broadcast program and at least a recorded program, as claimed by the applicant.

Therefore, the examiner respectfully believes that the art of record teaches all the limitations of applicant's invention as claimed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims **106-114, 116-124, 126-134 and 136-144** are rejected under 35 U.S.C. 102(e) as being anticipated by Schein et al. (hereinafter 'Schein', Pub. No. 2003/0196201).

Regarding claims 106, 116, 126 and 136, Schein teaches a system (with respective method and computer readable medium) for an interactive television program guide that provides a user with access to broadcast television programs and recorded programs stored on a digital storage device in the user's equipment, the system comprising:

a digital storage device for recording programs ([0039]); and

a display device (**80, Fig. 3**) for providing to the user a list of selectable options (**Pull down menu 114, Fig. 6B; [0045]; [0051] or as incorporated by reference, Young [Patent No. 5,353,121], hereinafter 'Young': Top 4 Selectable cells on Fig. 4, col. 16 lines 15-31**), wherein a first selectable option is provided for allowing the user to access information for at least one broadcast television program and at least one recorded program stored on the digital storage device (**Channel Guide, Fig. 6C, where broadcast programs are shown and recorded programs are highlighted to identify them, [0054], or Young: col. 8 lines 19-48 or Young: 'On Grid Prog' option in Fig. 4**), and wherein a second selectable option is provided for allowing the user to access a list of recorded programs stored on the digital storage device (**Recordings, Fig. 6C, where a list of recordings is displayed in the same way as if 'Favorites and Reminders' choice is selected and used as an example in Fig. 6D or Young: 'Recorded Programs' option, fig. 4**).

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Regarding claims 107, 117, 127 and 137, Schein teaches a system (with respective method and computer readable medium) wherein the digital storage device is configured to store program data associated with the recorded program **(Young: col. 19 lines 53-61, col. 13 line 64-col. 14 line 46).**

Regarding claims 108, 118, 128 and 138, Schein teaches a system (with respective method and computer readable medium) further comprising allowing the user to interact with the stored associated program data during playback of the recorded program **(Young: The user is able to interact with the stored associated data: searching the data by moving the cursor on the titles of the recorded programs for playback, col. 11 lines 47-65, or when searching through playback, or high speed repositioning, the title info will be displayed to the user, col. 13 line 64-col. 14 line 46).**

Regarding claims 109, 119, 129 and 139, Schein teaches a system (with respective method and computer readable medium) wherein the associated program data includes user added information **(Young: Updating or adding of related data can be performed by the user, col. 12 lines 31-35).**

Regarding claims 110, 120, 130 and 140, Schein teaches a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to access a list of programs scheduled to be recorded **(Young: Pending Recordings option, Fig. 4).**

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Regarding claims 111, 121, 131 and 141, Schein teaches a system (with respective method and computer readable medium) further comprising:

providing the user with an opportunity to select a program listing for a program scheduled to be recorded (**Young: To-be-recorded program 26 in Fig. 6, can be selected from the schedule that also includes to-be-recorded programs**); and

displaying an information screen for the selected program in response to the user selecting the program scheduled to be recorded (**Young: 52, Fig. 6 is displayed whenever a cell on the program schedule, col. 9 lines 9-50**).

Regarding claims 112, 122, 132 and 142, Schein teaches a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to transfer the stored program to a removable storage device (**Although the recording media could be removable, it is well known in the art of recording media the ability of copying or dubbing content to a removable media**).

Regarding claims 113, 123, 133 and 143, Schein teaches a system (with respective method and computer readable medium) further comprising:

providing a selectable option that allows the user to access a set-up screen (**Clicking on a program will open a set-up screen, InfoMenu 130, Fig. 8B, [0053]**); and

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providing the user with an opportunity to define one or more recording options using the set-up screen (**By selecting 'Record this program' option from the set-up screen, user can define recording options, Fig. 8C, [0053]**).

Regarding claims 114, 124, 134 and 144, Schein teaches a system (with respective method and computer readable medium) further comprising:

providing the user with an opportunity to define one or more playback options using the set-up screen (**'Restrict access to this program' option, Fig. 8B**).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **115, 125, 135 and 145** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (hereinafter 'Schein', Pub. No. 2003/0196201) in view of Goldschmidt Iki et al. (hereinafter 'Goldschmidt', Patent No. 6,226,444).

Regarding claims 115, 125, 135 and 145, Schein teaches all the limitations of the claims they depend on. On the other hand, Schein does not explicitly teach a system further comprising:

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determining whether the digitally stored programs include advertisements; and providing the user with an opportunity to play back the recorded program without displaying the advertisements.

However, in an analogous art, Goldschmidt teaches an (EPG 500, Fig. 5) from which setting a recording without commercials is possible (620, Fig. 6) and consequently, the playback of said program without commercials.

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Schein's invention with the no-commercials recording feature as taught by Goldschmidt for the benefit of having a continuous playback of a program without the interruption of commercials or for saving storage space of unnecessary material to the viewer.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP
/Christopher Grant/
Supervisory Patent Examiner, Art Unit 2623